

**REMARKS:**

Claims 1-3, 7-14, 18-25, and 29-35 are currently pending in the application.

Claims 4-6, 15-17, and 26-28 have been previously canceled *without prejudice*.

Claim 1 stands objected to because of certain informalities.

Claims 1-3 and 7-11 stand rejected under 35 U.S.C. § 112.

Claim 35 stands rejected under 35 U.S.C. § 102(e) over U.S. Patent No. 6,895,383 to Heinrich ("*Heinrich*").

Initially, the Applicants respectfully note that *Heinrich*, which issued on 17 May 2005, was filed on 29 March 2002. The subject Application was filed on 5 November 2001. Therefore, *Heinrich* is not valid prior art. Although *Heinrich* claims priority to provisional application no. 60/279,987, filed on 29 March 2001, the provisional application does not contain all of the Figures or disclosure of *Heinrich*, which issued on 17 May 2005, was filed on 29 March 2002, therefore, *Heinrich* is not valid prior art.

In addition, the Applicants believe, that the Applicants will be able to satisfy the requirements of 37 C.F.R § 131 by filing a declaration showing a completion of the present invention prior to 29 November 2001, and respectfully reserve Applicants right to do so in the future during the pendency of the subject Application. The Applicants also believe, however, that the present invention is not disclosed or fairly suggested by *Heinrich*, and therefore, transgresses the rejection of the Applicants Claims for the reasons recited below.

The Applicants respectfully submit that all of the Applicants arguments and amendments are without *prejudice* or *disclaimer*. In addition, the Applicants have merely discussed example distinctions from the cited prior art. Other distinctions may exist, and as such, the Applicants reserve the right to discuss these additional distinctions in a future Response or on Appeal, if appropriate. The Applicants further respectfully submit that by not responding to additional statements made by the Examiner, the Applicants do not acquiesce to the Examiner's additional statements. The example distinctions discussed by

the Applicants are considered sufficient to overcome the Examiner's rejections. In addition, the Applicants reserve the right to pursue broader claims in this Application or through a continuation patent application. No new matter has been added.

**CLAIM OBJECTION:**

Claim 1 stands objected to because of certain informalities. Specifically, the Examiner states that "Claim 1 recites in the preamble, '...processing units operate to...' it appears Applicant meant *operable* to". (16 November 2007 Final Office Action, Page 2). (Emphasis Original).

In response, the Applicants have amended independent Claim 1. In addition, the Applicants respectfully submit that the amendment to independent Claim 1 is not necessitated by any prior art and is unrelated to the patentability of the present invention. The Applicant respectfully requests that the objection to amended independent Claim 1 be reconsidered and that amended independent Claim 1 be allowed.

**REJECTION UNDER 35 U.S.C. § 112:**

Claims 1-3 and 7-11 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Applicants respectfully disagree.

Nonetheless, the Applicants have amended independent Claim 1 to further clarify that this claim particularly points out and distinctly claims the subject matter which Applicants regard as the invention. The Applicants further respectfully submit that this amendment is not considered narrowing or necessary for patentability. By making this amendment, the Applicants do not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of Claims 1-3 and 7-11 under 35 U.S.C. § 112, as set forth in the Office Action.

The Applicants respectfully submit that amended independent Claim 1 is considered to be in full compliance with the requirements of 35 U.S.C. § 112. The Applicants further respectfully submit that amended independent Claim 1 is in condition for allowance.

With respect to dependent Claims 2, 3, and 7-11, these claims depend from amended independent Claim 1. As mentioned above, amended independent Claim 1 is considered to be in full compliance with the requirements of 35 U.S.C. § 112. Thus, dependent Claims 2, 3, and 7-11 are considered to be in condition for allowance for at least the reason of depending from an allowable claim. Thus, the Applicants respectfully request that the rejection of Claims 1-3 and 7-11 under 35 U.S.C. § 112 be reconsidered and that Claims 1-3 and 7-11 be allowed.

In addition, the Applicants respectfully request that the Examiner call the undersigned, Steven J. Laureanti, at (480) 830-2700, if the Examiner has additional comments or suggestions to the 35 U.S.C. § 112 rejection of the subject Application or if the Examiner believes it would be easier to discuss the 35 U.S.C. § 112 rejection over the telephone.

**REJECTION UNDER 35 U.S.C. § 102(e):**

Claim 35 stands rejected under 35 U.S.C. § 102(e) over *Heinrich*.

As discussed above, the Applicants respectfully reserve the right to satisfy the requirements of 37 C.F.R. § 131 by filing a declaration showing a completion of the present invention prior to 29 November 2001, in the future during the pendency of the subject Application. However, the Applicants believe that the present invention is not disclosed or fairly suggested by *Heinrich*, and therefore, transverse the rejection of Claims 1, 3, 9-12, 14, 20-23, 25, and 31-35 for the reasons recited below.

The Applicants respectfully submit that the ***amendments to independent Claim 35 have rendered moot the Examiner's rejection of Claim 35 and the Examiner's arguments in support of the rejection of Claim 35.*** The Applicants further respectfully

submit that amended independent Claim 35 in its current amended form contains unique and novel limitations that are not taught, suggested, or even hinted at in *Heinrich*. In addition, the Applicants respectfully submit that *Heinrich* fails to disclose, teach, or suggest each and every limitation recited in Claims 35. The Applicants further respectfully submit that Claim 35 patentably distinguish over *Heinrich*. Thus, the Applicants respectfully traverse the Examiners rejection of Claim 35 under 35 U.S.C. § 102(e) over *Heinrich*.

### **The Applicants Claim 35 is Patentable over *Heinrich***

Independent Claim 35 is considered patentably distinguishable over *Heinrich*. Thus, for at least the reasons set forth herein, the Applicants respectfully submit that independent Claim 35 is not anticipated by *Heinrich*. The Applicants further respectfully submit that independent Claim 35 is in condition for allowance. Thus, the Applicants respectfully request that the rejection of Claim 35 under 35 U.S.C. § 102(e) be reconsidered and that Claim 35 be allowed.

### **THE LEGAL STANDARD FOR ANTICIPATION REJECTIONS UNDER 35 U.S.C. § 102:**

The following sets forth the legal standards for "anticipation."

The events that can lead to anticipation can be divided into the following seven categories, all defined by statute:

1. Prior Knowledge: The invention was publicly known in the United States before the patentee invented it.
2. Prior Use: The invention was publicly used in the United States either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.
3. Prior Publication: The invention was described in a printed publication anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.

4. Prior Patent: The invention was patented in another patent anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his application.

5. On Sale: The invention was on sale in the United States more than one year before the patentee filed his application.

6. Prior Invention: The invention was invented by another person in the United States before the patentee invented it, and that other person did not abandon, suppress or conceal the invention.

7. Prior U.S. Patent: The invention was described in a patent granted on a patent application filed in the United States before the patentee made the invention.

Each of those seven events has its own particular requirements, but they all have the following requirements in common:

1. Anticipation must be shown by clear and convincing evidence.
2. If one prior art reference completely embodies the same process or product as any claim, the product or process of that claim is anticipated by the prior art, and that claim is invalid. To decide whether anticipation exists, one must consider each of the elements recited in the claim and determine whether all of them are found in the particular item alleged to be anticipating prior art.
3. There is no anticipation unless every one of those elements is found in a *single* prior publication, prior public use, prior invention, prior patent, prior knowledge or prior sale. One may not combine two or more items of prior art to make out an anticipation. One should, however, take into consideration, not only what is expressly disclosed or embodied in the particular item of prior art, but also what inherently occurred in its practice.
4. There cannot be an accidental or unrecognized anticipation. A prior duplication of the claimed invention that was accidental, or unrecognized, unappreciated, and incidental to some other purpose is not an invalidating anticipation.

Those four requirements must be kept in mind and applied to each kind of anticipation in issue. The following additional requirements apply to some categories of anticipation.

1. Prior Knowledge: An invention is anticipated if it was known by others in the United States before it was invented by the patentee. "Known," in this context, means known to the public. Private knowledge, secret knowledge or knowledge confined to a small, limited group is not necessarily an invalidating anticipation. Things that were known to the public only outside the United States are not invalidating anticipation.

2. Prior Use: An invention is anticipated if it was used by others before it was invented by the patentee, or more than one year before the patentee filed his patent application. "Use," in this context, means a public use.

3. Prior Publication: A patent is invalid if the invention defined by the claims was described in a printed publication before it was invented by the patentee or more than one year prior to the filing date of his application. For a publication to constitute an anticipation of an invention, it must be capable, when taken in conjunction with the knowledge of people of ordinary skill in the art, of placing the invention in the possession of the reader. The disclosure must be enabling and meaningful. In determining whether the disclosure is complete, enabling, and meaningful, one should take into account what would have been within the knowledge of a person of ordinary skill in the art at the time, and one may consider other publications that shed light on the knowledge such a person would have had.

4. Prior Patent: If the invention defined by the claims was patented in the United States or a foreign country, either before it was invented by the inventor or more than one year before the inventor filed his patent application, then the invention was anticipated. The effective date for this type of anticipation is the date on which two things co-existed: (i) the owner of the referenced patent had the right to enforce that patent; and (ii) the reference patent was available to the public. What was "patented" in the reference patent is determined by what is defined by its claims, interpreted in the light of the general description.

5. On Sale: A patent is invalid if the invention claimed in it was on sale in the United States more than one year prior to the application filing date.

6. Prior Invention: If the invention defined by the claims was invented by another person, in the United States, before it was invented by the inventor, and that other person did not abandon, suppress, or conceal the invention, the invention lacks novelty. A prior invention, even if put in physical form and shown to produce the desired result, is not an invalidating anticipation unless some steps were taken to make it public. However, it is not necessary that the inventor had knowledge of that prior invention.

7. Prior U.S. Application: A patent is invalid for lack of novelty if the invention defined by the claims was described in a United States patent issued on a patent application filed by another person before the invention was made by the inventor. The effective date of a prior application for purposes of this issue is the date on which it was filed in the United States. Foreign-filed patent applications do not apply. If the issued United States patent claims the benefit of more than one United States application, its effective date as an anticipation is the filing date of the first United States application that discloses the invention claimed in that referenced patent.

Experimental Use Exception: The law recognizes that it is beneficial to permit the inventor the time and opportunity to develop his invention. As such there is an "experimental use" exception to the "public use" and "on sale" rules. Even though the invention was publicly used or on sale, more than one year prior to the application filing date, that does not invalidate the patent, provided the principal purpose was experimentation rather than commercial benefit. If the primary purpose was experimental, it does not matter that the public used the invention or that the inventor incidentally derived profit from it.

When a public use or sale is shown, the burden is on the inventor to come forward with evidence to support the experimental use exception. Only experimentation by or under the control of the inventor qualifies for this exception. Experimentation by a third party, for its own purposes, does not qualify for this exception. Once the invention leaves the inventor's control, its use is a public one, even if further experimentation takes place.

The experimentation must relate to the claimed features of the invention. And it must be for the purpose of technological improvement, not commercial exploitation. If any commercial exploitation does occur, it must be merely incidental to the primary purpose of experimentation. A test done primarily for marketing, and only incidentally for technological improvement, is a public use.



**CONCLUSION:**

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although the Applicants believe no fees are deemed to be necessary; the undersigned hereby authorizes the Director to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**. If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

**Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.**

Respectfully submitted,

26 November 2007  
Date

/Steven J. Laureanti/signed  
Steven J. Laureanti, Registration No. 50,274

BOOTH UDALL, PLC  
1155 W. Rio Salado Pkwy., Ste. 101  
Tempe AZ, 85281  
214.636.0799 (mobile)  
480.830.2700 (office)  
480.830.2717 (fax)  
steven@boothudall.com

**CUSTOMER NO. 53184**